

REMARKS

This response is to the Office Letter mailed in the above-referenced case on January 26, 2007, and made Final, in which the Examiner imposed all new grounds of rejection in the ninth round of examination. The applicant and his agent are fully aware that this practice is tolerated, and even encouraged in the Office, and is becoming much more frequent. Still, the applicant, an individual inventor, not a corporation with deep pockets, should have a right to expect that all of the art available would be cited and applied at some point prior to a ninth round of examination. The applicant and his agent are aware, too, that in the event we are able to overcome the rejections in the present action, that the Examiner can do another search and craft another rejection, at least as good as the last one, and never have to even consider allowing the case.

Still, there is little choice but to respond, and ask that if there is more art yet unmentioned and not shared with the applicant, and more rejections not yet applied, that it all get done in the next round. This same request was made in the last round, resulting in another new ground of rejection, so the applicant is entertaining some hope that perhaps the Office is not holding back any art at this juncture.

The Examiner now rejects claims 8-25 under 35 U.S.C. 102(a) over Giniger, US 6,199,045, hereinafter Giniger.

The applicant has caused the two independent claims, 8 and 17, to be presented below as last amended:

8. An information system for delivering position-related information to a portable digital appliance, comprising:

a tracking system for tracking position of the appliance;

a data repository comprising data entities each identified by position within one or more bounded regions and by different information subject categories or specific sub-categories; and

a client profile recording specific information subject categories or specific sub-categories of interest for a user of the digital appliance;

wherein the information system selects data entities from the data repository to be provided to the appliance according to the position of the appliance and the specific information subject or specific sub-categories of interest of the digital appliance and indicated in the client profile.

17. A method for delivering position-related information to a portable digital appliance, comprising the steps of:

(a) tracking position of the appliance;

(b) storing a client profile indicating a specific subject categories or specific sub-categories of interest for a user of the appliance; and

(c) selecting data entities from a data repository in which individual ones of the data entities are identified by both position of the appliance and subject categories of interest, to be provided to the appliance according to the position of the appliance and the specific subject categories of interest of the user of the appliance and indicated in the client profile.

The applicant believes the heart of the matter in this rejection is whether the reference Giniger really anticipates the limitations:

(1) "...storing a client profile indicating a specific subject categories or specific sub-categories of interest for a user of the appliance..." and

(2) "...selecting data entities from a data repository in which individual ones of the data entities are identified by both position of the appliance and subject categories of interest, to be provided to the appliance according to the position of the appliance and the specific subject categories of interest of the user of the appliance and indicated in the client profile...".

The applicant's position is that the reference absolutely does not anticipate either

limitation (1) or (2). In regard to limitation (1), the only teaching in the reference the applicant find is the one the Examiner refers to peripherally, that is, "a user preference", and this term occurs only in the Abstract as "The response information may further be in correspondence with user preferences". There is no teaching that the user preference alluded to in the abstract of Giniger might be a specific category or sub-category of interest to the user. It may be, for example, a preference that the system responds in French rather than English. There is some allusion in the Background to art display, historical information, and the like, but there is nowhere any connection of these two pieces of disclosure that the user preference might be related to such categories; only that the information provided might of such a nature. Further, there is no teaching whatever in Giniger that the applicant can thus far discover that there is a user profile in the system for individual users or individual appliances.

The applicant has to conclude that the teaching in Giniger that the Examiner relies upon in regard to these limitations is completely inadequate to sustain a 102(e) rejection. Giniger simply does not teach a user profile storing a client's categories or subcategories of interest; therefore there is no teaching that such may be used in selecting different date entities for response.

So it is clear that the limitations of the user profile, the categories of interest, and the use of same to select information to send to a user are limitations in the standing claims that are simply not anticipated in the Giniger reference, and render the claims patentable over Giniger. Therefore independent claims 8 and 17 are patentable over Giniger, and claims 9-16 and 18-25 are patentable at least as depended from a patentable claim.

In addition to the above, applicant wishes to point out that claims 11 and 20 have a limitation that the information selected by the system to send to the appliance is selected at least in part by the direction of movement of the appliance. There is no such teaching in Giniger; therefore claims 11 and 20 are patentable on their merits, as well as patentable as depended.

Further to all of the above applicant draws the examiner's attention to the fact that a terminal disclaimer was filed on 12.20.2005 and accepted by the examiner in this case, disclaiming a portion of the term of any patent that may issue from this application over a patent US 6081780. That disclaimer was a result of a typographical error, and the disclaimer must be removed from the case. US 6081780 is not in the chain or priority for this case, is not owned by the present inventor, and there is no reason that any portion of a patent should be disclaimed over that patent.

The applicant respectfully requests that the examiner respond to this request in the next communication from the office.

If there are any time extensions due beyond any extension requested and paid with this amendment, such extensions are hereby requested. If there are any fees due beyond any fees paid with the present amendment, such fees are authorized to be deducted from deposit account 50-0534.

Respectfully Submitted,
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